

REMARKS

Prior to entry of this amendment, claims 1, 17-29 and 65-67 are pending in the subject application. By the instant amendment, claims 1, 17-23, 26-29, 66 and 67 are amended, claims 24, 25 and 65 are cancelled, and claims 68-70 are added. Claim 1 is the sole independent claim.

Claims 1, 17-23, 26-29 and 66-70 are presented to the Examiner for further or initial prosecution on the merits.

A. Introduction

In the outstanding Office action, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a); and rejected claims 1, 17-29 and 65-67 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

B. Discussion Regarding the Subject Matter Recited in Claim 1

Applicants note that all of the outstanding objections and rejections are based on a purported lack of description and illustration of the following aspect of claim 1: “wherein the first excitation coil portion is electrically connected to the second excitation coil portion by a first via and the first pick-up coil portion is electrically connected to the second pick-up coil portion by a second via.” By the instant amendment, this subject matter has been removed from the claims.

C. Objection to the Drawings

In the outstanding Office action, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a) and asserted that the drawings must show every feature of the invention or the feature(s) cancelled from the claims, viz., “wherein the first excitation coil portion is electrically connected to the second excitation coil portion by a first via and the first pick-up coil portion is electrically connected to the second pick-up coil portion by a second via,” as recited in claim 1. Applicants respectfully traverse this objection, as instant amendment

removes the noted subject matter from the claims. Therefore, applicants respectfully request that this objection be reconsidered and withdrawn.

D. Asserted Rejection of Claims under 35 U.S.C. § 112, first paragraph

In the outstanding Office action, the Examiner rejected claims 1, 17-29 and 65-67 under 35 U.S.C. §112, first paragraph. The phrase “wherein the first excitation coil portion is electrically connected to the second excitation coil portion by a first via and the first pick-up coil portion is electrically connected to the second pick-up coil portion by a second via,” as recited in claim 1, has been identified by the Examiner as forming the basis for the rejection. As noted above, the instant amendment removes the noted subject matter from the claims. Therefore, applicants respectfully request that this rejection be reconsidered and withdrawn.

E. Remarks Regarding the Rejections Set Forth in the Previous Office Action, mailed January 3, 2007

As set forth below, applicants respectfully submit that the claims as amended by the instant amendment are patentable over the prior art of record. With regard to the previously-asserted prior art rejections set forth in the Office action mailed January 3, 2007, applicants present the following remarks.

1. The rejection under 35 U.S.C. § 103(a) over the Fedeli et al., Glowacki et al. and Kawahito et al. references

In the January 3rd Office action, the Examiner rejected claims 1 and 17-20 under 35 U.S.C. § 103(a) over the proposed combination of U.S. Patent No. 6,690,164 to Fedeli et al. (“the Fedeli et al. reference”), U.S. Patent No. 6,251,834 to Glowacki et al. (“the Glowacki et al. reference”) and Japanese Patent Application Publication No. JP 08-179023 (“the Kawahito et al. reference”). Applicants respectfully submit, however, that the subject matter presently recited in the claims is not suggested, much less disclosed, by the proposed combination of these references.

For example, claim 1 presently recites, *inter alia*, “wherein the first soft magnetic core is disposed on a first surface of the dielectric substrate and the second soft magnetic core is disposed on a second surface of the dielectric substrate opposite the first surface.” The Examiner previously asserted that the Kawahito et al. reference discloses,

the first soft magnetic core is disposed on a first side of the dielectric substrate, the second soft magnetic core is disposed on a second side of the dielectric substrate ((Figure 1) and (Abstract, Constitution) / note cores on left side (first side) and right side (second side)).

(Office action mailed January 3, 2007, paragraph no. 7, page 5).

However, this assertion is inconsistent with the Examiner’s argument that the Fedeli et al. reference teaches the first and second magnetic cores as being perpendicular.¹ In particular, the Examiner asserted that the Fedeli et al. reference teaches perpendicular first and second magnetic cores, but the Kawahito et al. reference clearly shows that the left- and right-side magnetic cores, i.e., the purported “first” and “second” magnetic cores, are parallel. Thus, the Examiner’s reliance on the Kawahito reference is in conflict with the teachings of the Fedeli et al. reference.

Moreover, the Kawahito et al. reference fails to disclose, or even suggest, that first and second magnetic cores are disposed on opposite surfaces of a dielectric substrate, as presently recited in claim 1. Further, this teaching is likewise absent from the Fedeli et al. and Glowacki et al. references. Thus, the applied prior art fails to render obvious the subject matter presently recited in claim 1.

2. The rejection under 35 U.S.C. § 103(a) over the Fedeli et al., Glowacki et al., Kawahito et al. and Choi et al. references

In the January 3rd Office action, the Examiner rejected claims 26-29 under 35 U.S.C. § 103(a) over the Fedeli et al., Glowacki et al. and Kawahito et al. references, and in further

¹ See the Office action mailed January 3, 2007, paragraph no. 7, page 4, wherein the Examiner asserted that the first magnetic core extends in a first axial direction and the second magnetic core extends in a second axial direction perpendicular to the first axial direction.

view of U.S. Patent No. 6,411,086 to Choi et al. ("the Choi et al. reference"). Applicants respectfully submit, however, that the subject matter presently recited in the claims is not suggested, much less disclosed, by the proposed combination of these references.

For example, further to subsection E(1) above, the Choi et al. reference fails to provide the teachings noted above as missing from the Fedeli et al., Glowacki et al. and Kawahito et al. references. Accordingly, the proposed combination of the Choi et al. reference with the Fedeli et al., Glowacki et al. and Kawahito et al. references fails to render obvious the subject matter recited in claim 1.

Further, the Choi et al. reference teaches, at most, magnetic cores 26 and 30 that are stacked one above the other on a substrate.² In contrast, claim 17 recites soft magnetic cores having parallel pairs of bar-type portions that extend along planes that are *parallel* to the substrate.

Moreover, applicants respectfully submit that the applied prior art fails to suggest, much less disclose, each and every aspect of the particular embodiments presently recited in claims 21-23, 68 and 69.

For at least the reasons set forth above, applicants respectfully submit that the presently pending claims are allowable over the applied prior art, and a notice to that effect is respectfully requested.

F. Conclusion

The above remarks demonstrate the failings of the Examiner's arguments with respect to the pending claims and demonstrate the patentability of the pending claims over the applied prior art. However, while these remarks may refer to particular claim elements, they are not intended to, nor need they, comprehensively address each and every reason for the

² See the Choi et al. reference at, e.g., drawing FIG. 5 and col. 4, lines 54 and 55.

patentability of the claimed subject matter over the applied art. Accordingly, applicants respectfully submit that the claims are allowable for reasons including, but not limited to, those set forth above, and patentability of the claims does not depend solely on the particular claim elements discussed above.

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.

Respectfully submitted,

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